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REMARKSRejection of Claims on Art Grounds and Traversal Thereof

Claims 3-17, 28-31 and 38-44 are pending in the application. Claims 1-2, 18-27 and 32-37 stand withdrawn from further consideration by the Examiner as being drawn to a non-elected invention. Applicant affirms that claims 3-17, 28-31 and 38-44 are selected for prosecution. However, Applicant reserves the right to file divisional applications for the presently withdrawn claims, and no inference of abandonment of the subject matter of the non-elected claims should be drawn.

In the 11 January 2005 Office Action, 3-17, 28-31 and 38-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boden et al. (US 5930512) in further view of Nauckhoff (US 5893128).

The above rejections of the claims 3-17, 28-31 and 38-44 are traversed, and consideration of the patentability of claims 3-17, 28-31 and 38-44 as amended, is requested in light of the ensuing remarks.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify

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the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217

F3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Boden et al patent and the cited Nauckhoff patent describe software tools for Workflow processes. The invention described by Boden et al uses hypertext markup language for building and running workflow processes. Nauckhoff describes a method for distributed workflow management in a distributed data processing system comprising node units connected in a network. The present invention also discloses a software tool for workflow processes. However, the software tool of the present invention as specifically claimed and now amended is novel and non-obvious over the cited references including the Kumashiro (US 6240395) and Garofalakis et al (5,845,279) patents, as well as the other prior art cited but not applied.

Specifically, none of the cited prior art discloses the step of displaying the versions of a workflow plan in a sequential manner to simulate animation of the edit history; wherein the step of displaying is visually distinctive as a function of frequency of change in the edit history.

Support for the above underlined matter can be found as original in the present application on page 43, in lines 22-27. Thus, no new matter has been added by this amendment. Moreover, there is no suggestion, teaching or motivation for combining the cited references to come up with

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the present invention. In addition, the references cited but not applied, alone or in combination fail to contain any teaching or suggestion of methods of the present invention.

CONCLUSION

In view of the foregoing, claims 3-17, 28-31 and 38-44 constituting the claims pending in the application, are submitted to be fully patentable and in allowable condition to address and overcome the rejections.

If any issues remain outstanding, incident to the allowance of the application, Examiner Stork is respectfully requested to contact the undersigned attorney at (919)-664-8222 or via email at jnang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant.

Respectfully submitted,

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TO: EXAMINER: STORK, ART UNIT 2178

ON April 5th 2005

(Date of Deposit)

Christian E. Carter-Seyboth
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